

REMARKS

Applicants would like to thank the Examiner for careful consideration of the pending application. Amendments to claims are presented above, and remarks regarding the Office Action dated July 7, 2005 are as follows.

Claims 1, 2, 4, 7-9, 11-12 and 15-16 are pending in the Application. Claims 5, 6, and 10 have been cancelled, and Claims 1, 2, 4, 7-9 and 11-12 have been amended. Support for all amendments can be found in the specification as originally filed. No new matter has been added.

REJECTIONS UNDER 112

Claims 1, 2, 4-12, 15, and 16 have been rejected under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

35 USC 112, second paragraph, essentially requires precision and definiteness of claim language. *In re Borkowski*, 164 USPQ 642 (CCPA 1970). Definiteness of claim language must be analyzed, not in a vacuum, but in light of (i) the context of the particular application disclosure, (ii) the teachings of the prior art, and (iii) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. See (MPEP 2173.02, *In re Wiggins*, 179 USPQ 421 (CCPA 1973)). If the scope of the subject matter embraced by the claim is clear, and if Applicant has not otherwise indicated that he intends that claim to be a different scope, then the claim does particularly point out and distinctly claim the subject matter which the applicant regards as his invention. *In re Borkowski* at 645-646.

A broad claim, no matter how broad, is not indefinite for purposes of section 112, second paragraph, as long as the boundaries of the claim are capable of being understood. Stated differently, breadth alone is not indefiniteness. See *In re Gardner*, 166 USPQ 138 (CCPA 1970).

Claims 1 and 4 stand rejected under 35 USC 112, second paragraph as the Examiner states that, "graft polymer is indefinite as to scope of meaning" and this

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"component reads on any polymer that has grafted moieties". In amended independent Claim 1, "graft polymers" has been further clarified to include graft polymers that are the product of polymerizing monomers of group B.1.1 with monomers of group B.1.2 (support for this amendment can be found on page 8, lines 20-27 of the specification as originally filed). Claim 4 has been amended to depend from amended independent Claim 1, and therefore, includes the limitations of amended independent Claim 1. Reconsideration of the Examiner's rejections is respectfully requested.

Claims 2 and 4 stand rejected under 35 USC 112, second paragraph, for failing to make a distinction between generic "mineral particles" and carbon particles. Applicants have attended to the Examiner's rejections by amending Claims 1 and 4 to further define "mineral particles" as "non-carbon based mineral particles". Furthermore, the distinction between the mineral particles of Claims 2 and 4 and carbon particles of Claim 1 is further clarified in view of the amendments to independent Claim 1. Reconsideration of the Examiner's rejections is respectfully requested.

REJECTIONS UNDER 35 USC 102 AND 103:

Claims 1, 2, 4, 10-12, 15 and 16 stand rejected under 35 USC 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as being obvious in view of over EP 0506386 (hereinafter referred to as "EP '386").

It is well established that in order for a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in prior art. The disclosure requirement under 35 USC 102 presupposes knowledge of one skilled in art of claimed invention, but such presumed knowledge does not grant license to read into prior art reference teachings that are not there. *See Motorola Inc. v. Interdigital Technology Corp.* 43 USPQ2d 1481 (1997 CAFC).

EP '386 discloses a composition comprising polyphenylene ether, a polyamide, carbon black, with other components and additives.

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The Examiner has compared the components of EP '386 to the components of the claimed invention as follows. 1) Polyphenylene ether is regarded as a claimed "graft" polymer, as polyphenylene ether is obtained by 'grafting' maleic anhydride onto polyphenylene ether, 2) nylon is regarded as the presently claimed polyamide, 3) SBS block copolymer is regarded as a claimed "further component", and 4) carbon black is regarded as presently claimed electrically conductive carbon.

EP '386 clearly fails to teach or suggest a molding composition or graft polymers as recited in amended independent Claim 1. In particular, EP '386 does not teach or suggest a molding composition that presently excludes polyphenylene ethers and modified polyphenylene ethers. Moreover, compositions prepared in accordance with amended independent Claim 1 clearly display higher stiffness, better shrinkage behavior and better coefficient of thermal expansion (See Table 1, page 27).

Accordingly, EP '386 does not disclose the graft polymers, nor the molding composition of amended independent Claim 1 and, therefore, does not disclose each and every element of amended independent Claim 1. Thus, Applicants submit that EP '386 does not anticipate amended independent Claim 1, and the Examiner's rejection under 35 USC 102(b) should be withdrawn. Reconsideration is respectfully requested.

The Examiner has asserted that one of ordinary skill in the art at the time of the invention could replace the SBS block copolymers of EP '386 with the rubber-modified graft polymers of pending application with a reasonable expectation of success.

In addition to the reasons hereinabove, Applicants submit that it would not be obvious to one skilled in the art to modify the disclosure of EP '386 by substituting graft polymers as described in amended independent Claim 1 for the polyphenylene ethers or modified polyphenylene ethers as described in EP '386. EP '386 is clearly directed to thermoplastic resins based on polyphenylene ethers. One skilled in the art would have little expectation of successfully developing a molding composition with comparable intrinsic properties by completely omitting the resin on which the

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composition is based (i.e. polyphenylene ethers). Therefore, the rejection under 35 USC 103(a) should be withdrawn. Reconsideration is respectfully requested.

Accordingly, EP '386 does not teach or suggest all the limitations of amended independent Claim 1, nor would one skilled in the art have a reasonable expectation of successfully modifying the disclosure to arrive at the currently claimed invention. Therefore, the rejection under 35 USC 103(a) should be withdrawn. Reconsideration is respectfully requested.

Claims 2, 4, 7-9 and 11-12, 15 and 16 either directly or indirectly depend from and add further limitations to amended independent Claim 1 and are deemed allowable for at least the same reasons in connection with amended independent Claim 1. Reconsideration of Claims 2, 4, 7-9, 11-12, 15 and 16 is respectfully requested.

REJECTIONS UNDER 35 USC 103

Claims 5-9 and 14 stand rejected under 35 USC 103(a) as being unpatentable over EP '386.

Claims 5, 6 and 14 are cancelled. Claims 7-9 depend from and add further limitations to amended independent Claim 1 and are deemed allowable for at least the same reasons in connection with amended independent Claim 1 as described hereinabove. Reconsideration is respectfully requested.

OBVIOUSNESS-TYPE DOUBLE PATENTING

Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims of copending Application Nos. 10/719,720, 10/737,321 and 10/796,525.

The Office Action alleges that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because they contain overlapping subject matter" (Office Action, page 6, lines 1-2).

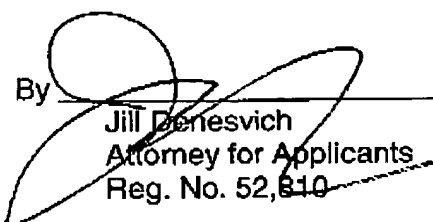
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Applicants submit both the present application and Application No. 10/737,321 and 10/796,525 are pending, and Application No. 10/719,720 is abandoned. Allowable subject matter, notwithstanding the provisional obviousness-type double patenting rejection, has not been indicated in either pending application. Where a provisional rejection under the judicially created doctrine of obviousness-double patenting is named between two applications, MPEP § 104(I)(B) states that "if the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the provisional rejection in the other application in a double patenting rejection at the time the one application issues as a patent." Therefore, it is not evident which of the pending applications will become allowable first, and any action by Applicants with this regard is premature.

In view of the above amendments and remarks, the Applicants submit that the claims presented herein are in condition for allowance. Reconsideration and allowance is respectfully requested.

Respectfully submitted,

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